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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Laura Raus

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EXAMINER

SIGLER, JAY R

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,721	Applicant(s) RAUS, LAURA	
	Examiner JAY R. SIGLER	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,24,26-30,32,34,35 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,24,26-30,32,34,35 and 40-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01 October 2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 24, 27-30, 32, 34, 35, 40-45, 47 and 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bent (US 3,752,161) in view of Cristiano (US 2,625,682).

a. Bent teaches a surgical device apt to the removal of bone, cartilaginous and the like tissues during surgery (see Abstract), comprising: a pair of side-by-side blades (20 and 22), slidably coupled so that respective distal ends thereof be closable the one against the other for the removal of a tissue fragment; propelling means 12, connected or connectible to a blade of said pair and apt to determine the sliding thereof with respect to the other of said blades; and operation means 16 for the operation of said propelling means by a user. Bent further discloses a trigger 16; propelling means are of a pneumatic type (col. 2, l. 40-46) with piston 104 and motion transmission member 100. Bent does not specifically teach a motion transmission member that is a lever.

Cristiano, however, teaches a motion transmission member that is a lever 16 attached to a piston 128 and pivotally mounted to a chassis of a device in

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order to transfer movement from the piston to another element (col. 4, l. 46-53).

It would have been obvious to someone of ordinary skill in the art at the time of the invention to substitute the motion transmission member of Cristiano, i.e. a lever, for the motion transmission member in the invention of Bent because the substitution of one motion transmission member for another would have yielded predictable results, namely to transfer movement from the piston to another element.

To further clarify, where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable

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as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

b. Concerning claim 24, Bent further discloses a plurality of osteotomy blades removably connectible to said propelling means (see col. 2, l. 60-65).

c. Concerning claims 27-30, 32, 34, 35, 40-45, 47 and 49, Bent further discloses the blades can rotate (see col. 4, l. 65 - col. 5, l. 2); supply valve 184; air intake (70 and 74; means for adjust the closing force and, therefore, the sliding speed of the blades that comprise flow adjusting means (conical section of 184) that depend on the user's speed of handling the operation means (col. 9, l. 42-56); and means capable of preventing bone entrapment 34.

3. Claims 26 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bent (US 3,752,161) in view of Cristiano (US 2,625,682) and further in view of Vilsmeier (US 6,351,659). Bent, in view of Cristiano, fairly suggests the claimed invention but not specifically having a neuro-navigation system and means for cooperation with said system. Vilsmeier teaches a neuro-navigation system (see figure 1) and means for cooperation with said system (21 or 22) attached to an instrument 20 in order to supply a link between the surgeon and diagnostic data (see col. 1, l. 25-30). It would have been obvious to someone of ordinary skill in the art at the time of the invention to include a neuron-navigation system and means for cooperation with said

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system in the modified invention of Bent, in view of Cristiano and Vilsmeier, in order to supply a link between the surgeon and diagnostic data.

4. Claims 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bent (US 3,752,161) in view of Cristiano (US 2,625,682) and further in view of De Satnick et al. (US 4,848,338). Bent, in view of Cristiano, fairly suggests the claimed invention but not specifically means for inhibiting operation of said propelling means. De Satnick et al. teaches surgical instrument with means 46 for inhibiting operation of propelling means in order allow the user the option of keeping blade members (embodied by 15 and 19) closed (col. 6, l. 51-63). It would have been obvious to someone of ordinary skill in the art at the time of the invention to include means for inhibiting operation of said propelling means in the modified invention of Bent, in view of Cristiano and De Satnick et al., in order allow the user the option of keeping blade members closed.

Response to Arguments

5. Applicant's arguments filed 12 August 2008 have been fully considered but they are not persuasive.

6. Concerning argument 4A: Firstly, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. **Ascertaining the differences between the prior art and the claims at issue.**
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The examiner has fulfilled the second step as shown by applicant, i.e. "Bent [does] not specifically [teach] a motion transmission member that is a lever".

Secondly, the cited passage from the MPEP states that "[t]he examiner **must** determine what is 'analogous prior art' for the purpose of analyzing the obviousness of the subject matter at issue" (emphasis added), not that the examiner must address a need. Therefore in response to applicant's argument that is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, **then be reasonably pertinent to the particular problem with which the applicant was concerned**, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Cristiano reference is directed to the problem of transmitting motion from a piston to another element.

7. Concerning argument 4B: The motion of 104 is being transmitted through 100 to the blade, therefore 100 is a motion transmission member.

8. Concerning argument 4C: In response to applicant's argument that that there is no hint how a substitution should be done, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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9. Concerning argument 4D: In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the lever (and not the piston) [is] on the side of the slidable blade") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAY R. SIGLER whose telephone number is (571)270-3647. The examiner can normally be reached on Monday through Thursday from 8 AM to 4 PM (EST).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. R. S./

Examiner, Art Unit 3775

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733